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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,429	01/31/2006	Masaya Kobayashi	03500.123386	5774
5514 7590 09/03/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
OSTRUP, CLINTON T				
ART UNIT		PAPER NUMBER		
3771				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/566,429

Applicant(s)

KOBAYASHI ET AL.

Examiner

CLINTON OSTRUP

Art Unit

3771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2007.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 28 June 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-854)
Paper No(s)/Mail Date 11/3/06, 4/2/07, 5/4/07
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-12 are pending in this application.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "31" has been used to designate both the base plate in figure 1 and a stopper in figures 15A & 15B. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-3 and 5-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Canon Inc., (JP 2003-290356 A) based on the machine translation provided by the Japanese Patent Office.**

Canon discloses a liquid medication cartridge (3) comprising an accommodating portion (100) for accommodating a liquid medication; a liquid discharge portion (116) having a discharge port (104) for discharging the liquid medication by using an ink jet technique; a communicating means (Figure 5) for establishing communication between the accommodating portion and the liquid discharge portion; and a filling means (via movement of 116) for filling the liquid discharge portion with the liquid medication. See: figures 1-5.

Regarding claim 2, the liquid medication cartridge characterized by Canon does not have an absorbing member in the accommodating portion.

Regarding claim 3, Canon discloses a liquid medication cartridge characterized in that the communicating means (figure 5) for establishing communication between the liquid discharge portion (116) and the accommodating (100) portion has a film isolating the liquid discharge portion (105) from the accommodating portion and a piercing member (top edge of 116) provided on the liquid discharge portion and the piercing member pierces the isolating film to establish communication between the liquid discharge portion and the accommodating portion.

Regarding claim 5, Canon discloses a liquid medication cartridge (3) characterized in that after establishment of communication between the liquid discharge portion (116) and the accommodating portion (100), the liquid discharge portion (116) is filled with the liquid contained in the accommodating portion.

Regarding claim 6, Canon discloses a liquid medication cartridge (3) characterized in that an inner volume of the accommodating portion (100) is reduced by

deforming a part of the accommodating portion (where 116 pierces 100), to fill the liquid discharge portion (116) with the liquid contained in the accommodating portion (100).

Regarding claim 7, Canon discloses a liquid medication cartridge (3) characterized in that a ratio of the inner volume of the accommodating portion (100) is reduced by deforming a part of the accommodating portion (when 116 pierces 100) is 40% or less (the amount drawn from 116 is less than 40% of the liquid in 100) of the inner volume of the entire accommodating portion.

Regarding claim 8, Canon discloses a liquid medication cartridge (3) characterized in that an inner volume of the accommodating portion (100) is reduced by the piercing member (top edge of 116) provided on the liquid discharge portion (116) entering the accommodating portion (100) and filling the liquid discharge portion (116) with the liquid contained in the accommodating portion.

Regarding claim 9, Canon discloses a liquid medication cartridge (3) characterized in that a ratio of the liquid overflowing from the liquid discharge portion (116) when filling the liquid discharge portion with the liquid contained in the accommodating portion (100) is 20% or less (the amount entering 116 would be less than 20% of the volume in 100) of an inner volume of the entire accommodating portion.

Regarding claim 10, Canon discloses an inhaler that allows a user to inhale a medication as liquid droplets, characterized by having a retaining portion for retaining the liquid medication cartridge (figure 1) and a control means (battery controlled discharge device) for controlling a liquid discharge portion.

Regarding claim 11, Canon discloses an inhaler that is a portable device and is capable of being carried about. See: figure 1.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canon Inc., (JP 2003-290356 A) based on the machine translation provided by the Japanese Patent Office, as applied to claims 1-10 above, and further in view of Landis et al., 4,648,393.

Canon discloses all the limitations of claims 4 & 12 except the communication means for establishing communication between the liquid discharge portion and the accommodating portion opens a communication passage blocked by a pressure applied from outside by reducing the pressure.

Landis et al., discloses a breath actuated inhaler that activates a switch and allows a blocked passageway (blocked by 56) to be opened and a medicament discharged by reducing the pressure in a passageway (when 56 is moved upward). See: figures 2 & 3.

Breath actuated inhalers are common in the art and It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized

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a breath actuated switch as taught by Landis in the device disclosed by Canon to ensure the dispenser is only actuated when it is inserted into a user's mouth.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Vogues (6,196,218); Voges (6,637,430); Morita (2004/0178106); Hess et al, (6,196,219); Goodall et al., (6,629,524).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CLINTON OSTRUP whose telephone number is (571)272-5559. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Clinton Ostrup/
Examiner, Art Unit 3771

/Justine R Yu/
Supervisory Patent Examiner, Art Unit 3771